

**REMARKS**

At the time of the Office Action dated April 5, 2006, claims 1-17 were pending and rejected in this application.

**CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 101**

On pages 2 and 3 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-17, is directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner is referred to page 42 of the Patent Office's Interim Guidelines with regard to patent subject matter eligibility, which is reproduced, in part, below:

As set forth in the patent eligible subject matter interim guidelines, a practical application of a 35 U.S.C. § 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result. Therefore the following tests are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter:

- (A) "not in the technological arts" test
- (B) Freeman-Walter-Abele test
- (C) mental step or human step tests
- (D) the machine implemented test
- (E) the per se data transformation test.

As readily evident, the Examiner's requirement that the invention be "limited to a practical application within the technological arts" is improper. Moreover, the Examiner's has placed improper limitations as to what is required to produce a "useful, concrete, and tangible result."

In State Street Bank and Trust Company v. Signature Financial Group, Inc.,<sup>1</sup> the court set forth the criteria for establishing statutory subject matter under 35 U.S.C. § 101 as follows:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to —process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See In re Warmerdam, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

Thus, as articulated above, the test for determining whether subject matter is patentable under 35 U.S.C. § 101 involves deciding if the subject matter produces a "useful, concrete, and tangible result."

*Applicants have established utility*

A discussion of the procedural considerations regarding a rejection based upon lack of utility (i.e., 35 U.S.C. § 101) is found in M.P.E.P. § 2107.02. Specifically, M.P.E.P. § 2107.02(I) states that:

regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112

In the fourth full paragraph on page 2 of the disclosure and within the "Summary of the Invention" section, Applicants stated the following:

It is therefore an object of the present invention to provide a method and system for moving a document between a document processing system and a document repository in a compact format, without unnecessary overhead.

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<sup>1</sup> 149 F.3d 1368, 47 USPQ2d 1596 (Fed Cir. 1998).

Applicants, therefore, have asserted a credible utility. As noted in M.P.E.P. § 2107.02(III)(A), the Court of Customs and Patent Appeals in In re Langer<sup>2</sup> stated the following:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. (emphasis in original)

Since a credible utility is contained in Applicants' specification, the utility requirement of 35 U.S.C. § 101 (i.e., whether the invention produces a useful, concrete, and tangible result) has been met. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-17 under 35 U.S.C. § 101.

**CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON**  
**SORGE ET AL., U.S. PATENT NO. 6,613,098 (HEREINAFTER SORGE), IN VIEW OF MOSLEY,**  
**"MICROSOFT OFFICE 97, PROFESSIONAL EDITION" (HEREINAFTER MOSLEY)**

On pages 3-6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Sorge in view of Mosley to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has improperly relied on Sorge to teach many of the claimed limitations. For example, independent claims 1, 5, 10, and 13 each recite:

- obtaining structural information describing the document structure;
- obtaining meta information describing the document properties;
- obtaining document content.

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<sup>2</sup> 503 F.2d 1380, USPQ 288 (CCPA 1974).

To teach the first limitation, the Examiner cited column 14, lines 1-43 of Sorge, and to teach the second limitation, the Examiner cited column 12, lines 45-67 and column 13, lines 1-34 of Sorge. Applicants respectfully disagree that these passages identically disclose the above-identified limitations.

The passages referred to by the Examiner are silent with regard to the document structure and document properties. Instead, the passages referred to by the Examiner are directed to the structure and properties of the content of the document. Therefore, the Examiner has failed to establish that Sorge teaches the first two of the above-identified limitations.

With regard to the claimed "creating a physical representation for the document ...", the Examiner stated the following:

See column 4, lines 20-67. Creating a physical representation is broadly interpreted by the Examiner. A proficient example of a physical representation would be the document data inserted into the cells by the rountripping [sic] methods taught by Sorge.

At the outset, Applicants note that the Examiner has employed the improper standard with regard to claim construction. The issue of claim construction analysis was revisited by the Federal Circuit in Ferguson Beauregard/Logic Controls et al. v. Mega Systems, LLC et al.<sup>3</sup> As stated by the Court in Ferguson:

We begin our claim construction analysis with the words of the claim. [cite omitted] "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point [ ] out and distinctly claim [ ] the subject matter which the patentee regards as his invention.' 35 U.S.C. § 112, ¶ 2." [cite omitted] In the absence of an express intent to impart a novel meaning to the claim terms, the words take on the full breadth of the ordinary and customary meanings attributed to them by those of ordinary skill in the art. [cite omitted] The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources. Some of these sources include the claims themselves, [cite omitted]; dictionaries and treatises, [cite omitted]; and the written description, the drawings, and the prosecution history [cite omitted].

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<sup>3</sup> 350 F.3d, 1327, 69 USPQ2d 1001 (Fed. Cir. 2003).

The Court in Ferguson further recognized that words can have different meanings to different people in different contexts, which can account for the many different ordinary meanings that are found in a dictionary. These ordinary meanings, however, are not necessarily reflective of the customary usage of a particular word or term by those skilled in the art. The Court then concluded that:

It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims of a patent.

Thus, the Examiner is not free to "broadly" interpret the phrase "physical representation" without reference to the ordinary and customary meaning given to that phrase by one skilled in the art. As a cursory review of the art reveals, the term "physical representation" for a document has a meaning specific to those skilled in this particular art. Thus, the Examiner's "broad" interpretation of the phrase "physical representation" is improper.

Not only has the Examiner improperly construed the term "physical representation," the Examiner's citation of column 4, lines 20-67 raises additional issues. The claimed limitation of "creating a physical representation ..." refers to the obtained structural information, meta information, and document content, which the Examiner asserted was disclosed within particular passages found in columns 9-14 of Sorge. The Examiner, however, has failed to establish how the teachings found in column 4, lines 20-67 relate to the other teachings in column 9-14, as recited in the claims.

#### Claims 2 and 7

The Examiner asserted that the claimed "the physical representation for the document is a binary format" is disclosed by column 7, lines 55-67 of Sorge. Applicants respectfully disagree.

Although this passage refers to a binary file, this passage also states that the collection of files (including the binary file) is part of the HTML document. Therefore, the combination of Sorge and Mosley cannot teach that "the created physical representation," which is a binary format, is transferred to a document repository. Since Sorge teaches that the documents are collected into an HTML document, any transference of a file into a document repository is done via the HTML document, not a document in a binary format, as claimed.

#### Claims 4 and 12

The Examiner's comments with regard to claims 4 and 12 are found on page 5 of the Office Action; however, upon reviewing the Examiner's comments, Applicants note that the Examiner fails to even assert that the combination of references teaches or suggests the claimed "serializing." Thus, the Examiner has failed to establish a prima facie case of obviousness.

#### Claims 5-9

With regard to these claims, the Examiner asserted on page 5 of the Office Action, the following:

the limitations reflect the methods comprising instructions used for performing the methods as claimed in numbers 1-4, and in further view of the following, are rejected along the same rationale.

The Examiner has committed gross error in making the above assertion. Claims 5-9 are directed to "moving a folder and documents contained therein." Claims 1-4, however, are completely silent with regard to a folder. Therefore, the Examiner's comments with regard to claims 1-4 do not establish that the combination of Sorge and Mosley teaches or suggests all of the claimed limitations recited therein.

It should, therefore, be apparent that the Examiner did not discharge the initial burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103. Thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-17 under 35 U.S.C. § 103 for obviousness based upon *Sorge* in view of *Mosley*.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

Application No.: 10/020,048

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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